

AMENDMENT UNDER 37 C.F.R. § 1.116
Appln. No. 09/883,391
Docket No. Q64978

REMARKS

Claims 1-20 are all the claims pending in the application. Claim 1 is the only independent claim.

Claim Rejection Under 35 U.S.C. § 112

Claim 1 is rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite. Specifically, the Examiner has alleged that the phrases "peak voltage" and "passage of time" are indefinite.

In response, Applicant has replaced the phrase "peak voltage" with the phrase --peak value--, as suggested by the Examiner. Moreover, Applicant has deleted the phrase "passage of time." In view of these Amendments, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. § 112, second paragraph.

Allowable Subject Matter

The Examiner has indicated that claim 9 and claim 10 would be allowable if rewritten in independent form including all of the recitations of base claim and any intervening claim. Applicant, however, holds in abeyance the rewriting of these claims in independent form until the Examiner has had a chance to consider the remarks below with respect to claim 1.

Claim Rejections Under 35 U.S.C. § 102 and §103

Claims 1-3 and 11-20 are rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Iwashita (US 5,467,001). Claims 4-8 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Iwashita in view of Mori (JP 06-225573).

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With respect to independent claim 1, Applicant respectfully traverses the rejection at least because Iwashita does not inherently, or necessarily, disclose all of the claim's recitations. For example, Iwashita does not teach the claimed motor control device including a means for providing overheat protection, having a motor current limit value calculating section for providing a motor current limit value that is an integrated value of a predetermined function of the phase current of the motor; wherein the motor current limit value obtained by the motor current limit value calculating section gradually decreases a peak value of a sine wave motor current.

Iwashita's discloses that the method prevents the maximum current from exceeding a motor current limit in order to prevent "possibly damaging the control elements, such as transistors and the motor itself." See Iwashita at 2:54-55). Applicant believes that in view of this disclosure, it is the Examiner's position that Iwashita's control method, because it prevents an over-current, must inherently prevent overheating.

However, a current limiter does not *inherently*, or necessarily, prevent overheating. In fact, it is easily *possible* for an over-current to damage control elements, such as transistors, without causing an overheat problem. The reverse is also true. The law on inherency is to the effect that the result must necessarily follow from the disclosed art¹. Since a current spike can

¹ The question of whether a claim limitation is inherent in a prior art reference is a factual issue. See, *Continental Can Co.*, 948 F.2d at 1268. The doctrine of inherency allows for "modest flexibility in the rule that 'anticipation' requires that every element of the claims appear in a single reference." *Id.* at 1269. "It is not, however, a substitute for determination of patentability in terms of § 103." *Id.* Moreover, inherency "may not be established by probabilities or possibilities." *Id.* at 1269. "The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Motorola* ... (footnote continued)

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damage various junction devices (semiconductors) or insulation barriers without any thermal effect, Iwashita does not necessarily disclose a means for providing overheat protection.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 1, and the rejection of dependent claims 2, 3 and 11-20 at least because of their dependency from claim 1.

Finally, Applicant respectfully requests that the Examiner withdraw the rejections of dependent claims 4-8 at least because of their dependency from claim 1 and because Mori, which was cited by the Examiner in an attempt to show limiting of d and q axial current by vector synthesizing, does not make up for the deficiencies in Iwashita discussed above.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Inc. v. Interdigital Technology Corp., 121 F.3d 1461, 1473 (Fed. Cir. 1997), citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983).

If a structure in a cited reference does not expressly disclose a claimed feature, but absolutely must include that claimed feature in order to function properly, then that feature is deemed to be inherently disclosed. *See, e.g., W.L. Gore*, 721 F.2d at 1554 (“[W]e are not persuaded that the “effect” of the processes disclosed in Smith and Sumitomo, an “effect” undisclosed in those patents, would be always to inherently produce or be seen always to produce products meeting all of the claim limitations.”) In other words, if there are two or more possibilities with respect to the non-disclosed feature, then the non-disclosed feature is not inherent.

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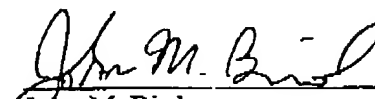
Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

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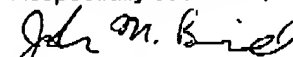
CUSTOMER NUMBER


John M. Bird
Registration No. 46,027

Date: January 6, 2005

I hereby certify that the above identified Amendment Under 37 C.F.R. § 1.116, is being facsimile transmitted to Examiner Tyrone W. SMITH at the Patent and Trademark Office on January 6, 2005 at (703) 372-9306.

Respectfully submitted,


John M. Bird